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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,487	01/28/2000	Andrew Sharp	34648/00430USPX	2310

7590 06/05/2003
Richard Moura Esq
Jenkins & Gilchrist PC
1445 Ross Avenue
Suite 3200
Dallas, TX 75202-2799

EXAMINER

NGUYEN, TU X

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 06/05/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/493,487

Applicant(s)

SHARP ET AL.

Examiner

Tu X Nguyen

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's arguments with respect to claims 1, 15 and 39 have been considered but are moot in previous rejection.
2. Applicants argue that "the recited references discussion is only made with respect to a single communication which is handed over between systems. There is no selection of communication or communications for handover in the event that the handover is necessary". The examiner disagrees because the modified Byrne discloses "the cellular cordless telephone continuously monitors for radio system availability, and automatically selects and re-selects radio systems, there exists the possibility of a new or different radio system" (see Byrne, col.6 lines 26-35), and the examiner interprets "radio system" corresponds to "communication".

With argument respect to claim 39, Byrne discloses in the abstract "Communication with respective radio telephone system may be simultaneously continued during handover until the handover is complete", which reads on "a call being place on hold or the handover of a call placed on hold" with broadest reasonable interpretation.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-25, 28, 30 and 33-39, are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne (US 5,737,703) and further in view of Lintulampi (US Patent 6,377,804).

Referring to claim 1, Byrne discloses a communication system comprising:

at least two different access networks, wherein a first access network is capable of handling a first number of communications between a mobile user equipment and the first access network, and wherein a second access network is capable of handling a second number of communications between the mobile user equipment and the second

Art Unit: 2684

access network (see fig.4 and col.3 lines 29-67), "DECT and GSM" reads on "access network".

Byrne fails to disclose at least one of the mobile user equipment and the communication system contain at least one means for evaluating if a handover between the UMTS material and GSM material should be effectuated and at least one means for selecting, in the case that the handover is necessary, which communication or communications are handed over and in that the at least one of the mobile user equipment and the communication system further contain at least one means for executing the at least one decision.

Lintulampi discloses at least one of the mobile user equipment and the communication system contain at least one means for evaluating (see col.4 lines 41-50) if a handover between the UMTS material and GSM material should be effectuated and at least one means for selecting (see fig.3 and col.4 lines 64-65), in the case that the handover is necessary, which communication or communications are handed over and in that the at least one of the mobile user equipment and the communication system further contain at least one means for executing the at least one decision (see col.5 line 40 through col.6 line 8). Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Byrne with the above teaching of Lintulampi in order to provide UMTS network operating in the 2GHZ frequency band and offering data transmission rates of up to 2 Mbits/sec, compared to a rate of 9.6 Kbits/sec offered by the existing GSM standard (as suggested by Lintuampi, see col.1 lines 14-26).

Regarding to claims 15 and 40, Byrne discloses method for managing a communication system, with at least two different access networks, wherein a first access network is capable of handling a first number of communications between a mobile user equipment and the first access network, and wherein a second access network is capable of handling a second number of communications between the mobile user equipment and the second access network (see col.3 lines 29-47), said method comprising the steps of:

selecting, in the case that the handover is necessary, which communication or communications are handed over (see col.3 lines 52-66 and col.6 lines 21-35).

Byrne fails to disclose evaluating if a handover from the first access network to the second access network should be effected .

Lintulampi discloses evaluating if a handover from the first access network to the second access network should be effected (see col. 4 lines 41-65), "analyses" correspond to "evaluating". Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Byrne with the above teaching of Tintulampi in order to provide a mobile station moves from one area to another area to de-register and re-register between two different networks.

Regarding to claims 2-14, the modified Byrnes discloses hand over between networks comprising at least one of the UMTS and GSM network contains the means for executing the at least one decision (see Lintulampi, col.2 lines 21-35); wherein the means for determining the capability is located in a core network (see Lintulampi, col.3 lines 44-50)

Referring to claims 16-18, 20-23 and 38, the modified Byrne discloses an access network sends a handover query to the mobile user equipment (see Lintulampi, col.4 line 20 through col.5 line 67).

Regarding to claim 19, the modified Byrne discloses enabling a mobile user to decide whether to communication or the communications should be handed over to the second access network (see Lintulampi, col.2 lines 21-31).

Regarding to claims 24-25, the modified Byrne discloses at least one decision about a communications which are handed over is the case that the mobile user equipment would move between the first access network and the second access network depends on at least one presetting (see Byrne, col.6 lines 21-35).

Regarding to claim 28, the modified Byrne discloses the presettings are stored within at least one of an access network and a core network (see Byrner, col.6 lines 23-26 and col.6 lines 51-55).

Regarding to claim 30, the modified Byrne discloses the access network and the core network store certain similar predetermined criterion or criteria for system identifications and requirements (see Byrne, col.6 lines 21-26).

Referring to claims 33-34, the modified Byrne discloses the presettings are defined and modified by an operator (see Lintulampi, col.3 lines 44-50).

Regarding to claims 35-37 and 39, the modified Byrne discloses everything as claim 15 above. More specifically, Byrne discloses "holding at least one of the communication before an intersystem handover; and maintaining said at least one of

the communications on hold during and after the intersystem handover" (see Byrne, abstract and col.8 lines 15-19).

6. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne, in view of Lintulampi and further in view of Naghshineh, M. et al. (End-to-end QoSprovisioning in Multimedia Wireless Mobile Networks Using an Adaptive Framework, November 1997, IEEE Communications Magazine, pp. 72-81).

Referring to claim 29, the modified Byrne fails to disclose the presettings can be different for each mobile user.

Naghshineh, M. et al. disclose a method, wherein presettings such as the quality-of-service (QOS) requirement of a network comprises varying degrees of network guarantee levels (page 73, left-hand column, lines 63-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of modified Byrne by incorporating the method, as taught by Naghshineh, M. et al, for the purpose of customizing the specific needs of each application.

7. Claims 26-27 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne, in view of Lintulampi and further in view of Acampora et al. [US 5497504].

Referring to claims 26 and 27, the modified Byrne fails to disclose the presettings are transferred to the core network via an initial user equipment message or a setup

message. Byrne further fails to disclose a presetting message is sent to the core network after the core network has sent a request to the mobile user equipment.

Acampora et al. disclose a negotiation of connection requirements between a mobile unit and a cell-cluster controller when a call request is initiated. Acampora et al. further disclose the cell-cluster controller, which reads on "a core network", queries the connection type of the call requested by the mobile unit. Upon receiving the connection type information, which reads on "a setup message", from the mobile unit, the cell-cluster controller makes rejection or admittance decision of the requested call based on the internal stored connection requirement table (Col. 7, lines 37-62). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Byrne by incorporating the method, as taught by Acampora, for the purpose of improving hand-shake protocol between the mobile unit and the core network.

Referring to claim 31, the modified Byrne fails to disclose the presettings can be different for different categories of communications.

Acampora et al. disclose presettings such as the number of guard channels allocated to hand-off calls is different to that of new calls (see col.2 lines 27-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Byrne by incorporating different presettings for different categories of communications, as taught by Acampora, for the purpose of better utilization of limit resources.

Referring to claim 32, the modified Byrne fails to disclose the presettings can be different for different categories of communications.

Art Unit: 2684

Acampora et al. disclose hand-off calls are afforded a higher priority of service by the base station over new calls when a system has limited available channels (see Col. 3 lines 37-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Byrne by incorporating priority status for different communication, as taught by Acampora, purpose of better utilization of limit resources.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu Nguyen whose telephone number is (703) 305-3427. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin, can be reached at (703) 308-6739.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 Customer Service Office at (703) 306-0377.

Any response to this action should be mailed to:

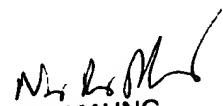
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

May 19, 2003


NAY MAUNG
PRIMARY EXAMINER